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In re Application of:
PACHUK, et al.
Application No.: 10/560,377
PCT Appln. No.: PCT/US2004/019229
Int. Filing Date: 10 June 2004
Priority Date: 12 June 2003
Attorney Docket No.: 26788-024
For: CONSERVED HBV AND HCV SEQUENCES
USEFUL FOR GENE SILENCING

PCT LEGAL ADMINISTRATION

DECISION

This decision is in response to the renewed petitions under 37 CFR 1.182 and 37 CFR 1.78 filed 09 September 2010 in the United States Patent and Trademark Office (USPTO). Applicant has provided payment of the appropriate petition fees.

BACKGROUND

On 30 July 2010, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.182 to convert the present U.S. National stage application filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a). A decision on the petition under 37 CFR 1.78 was held in abeyance pending resolution of any renewed petition under 37 CFR 1.182.

On 09 September 2010, applicant filed the petitions discussed herein.

DISCUSSION

As detailed in the decision mailed 30 July 2010, while counsel requested that this application, intended as a continuation-in-part, be converted to an application under 35 U.S.C. 111(a). The situation presented in the instant case is analogous to the filing of a similar preliminary amendment or substitute specification in a request for a CPA or RCE, as discussed at MPEP 201.06(d). As such, it would not be appropriate to convert this application. Instead, under these circumstances, petitioner is required to file a petition under 37 CFR 1.182 identifying and requesting removal from the present application file of the specific "disclosure materials that differ from" those present in the international application, and requesting treatment of said materials being removed as a new (CIP) application filed under 35 U.S.C. 111(a). Any such petition should be accompanied by the appropriate filing fee payment for the application as filed under 35 U.S.C. 111(a), as well as any application papers which would be required to create a complete application file (e.g., specification, claims and drawings) for the 35 U.S.C. 111(a) application.

In the instant case, applicant has filed such a petition under 37 CFR 1.182, identifying the specific papers presently filed which are to be used in the newly-created application under 35 U.S.C. 111(a). However, applicant was advised that because a significant period of time had elapsed from the filing of the above-captioned application, before such petition could be granted, applicant was required to file a terminal disclaimer under the provisions of 37 CFR 1.321 (b) disclaiming the terminal part of the term of a patent to be granted equivalent to the period

between the filing date of a grantable petition under 37 CFR 1.182 to create the CIP application and the filing date under 35 U.S.C. 111 (a) of such application.

A review of the presently filed renewed petition and accompanying exhibits finds that applicant has provided the necessary terminal disclaimer disclaiming the terminal part of the term of a patent to be granted equivalent to the period between the filing date of a grantable petition under 37 CFR 1.182 to create the CIP application and the filing date under 35 U.S.C. 111 (a) of such application. As such, it is proper to grant applicant's renewed petition at this time and have the papers filed 04 December 2009 treated as a U.S. utility application under 35 U.S.C. 111 (a).

Applicant's newly created utility application is serial number 13/065,601. A copy of this decision will be placed in application 13/065,601 as well. Similarly, a decision on applicant's petition under 37 CFR 1.78 will be handled separately in that application.

Applicant is advised that the substitute specification and preliminary amendment to the claims in the 35 U.S.C. 111(a) application will not be entered as the changes were made relative to the international application and thus do not correspond with the specification and claims being used to create utility application 13/065,601.

CONCLUSION

For the reasons stated above, the renewed petition under 37 CFR 1.182 is **GRANTED**.

This application is being returned to the Office of PCT Operations, National stage for continued processing.

The papers filed 04 December 2009 will be removed, along with the relevant fee payments to create utility application 13/065,601.



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